

REMARKS

I. Introduction

In the Current Action:

The FIGURES are objected to under 37 CFR 1.83(a);

Claims 1-11 are rejected under 35 U.S.C. § 112, second paragraph;

Claims 1-7, 10, and 12-21 are rejected under 35 U.S.C. § 102(e); and

Claims 8, 9, and 11 are rejected under 35 U.S.C. § 103(a).

This Response:

Adds FIGURE 3;

Amends the specification to accommodate the addition figure;

Amends Claims 2, 5, 6, 7, 8, 12;

Cancels claims 1, 13, and 21; and

Add claims 22-25.

The Applicant respectfully asks the Examiner to reconsider and withdraw the outstanding rejections and objections, in light of the comments herein. Claims 2 and 5-8 have been amended to change their dependency from canceled claims to new Claim 22. Claim 12 has been amended to more clearly describe the claimed invention. No new matter has been entered. Claims 2-12, 14-20, and 22-25 are pending in the present application.

II. New Claims

The Applicant has added new claims 22-25. Support can be found for these claims, among other places, at paragraphs 12, 14 and 15 of the specification. The Applicants respectfully submit that claims 22-25 are patentable over the references of record, and respectfully ask the Examiner to pass them to allowance.

III. The Objections to the Figures

The Applicant respectfully submits that new FIGURE 3 traverses the objections of the Current Action. No new matter has been added, and support for this FIGURE can be found in the originally filed specification at paragraphs 12, 14, and 15.

AMENDMENTS TO THE DRAWINGS

Attached to this response is an additional drawing labeled FIGURE 3.

IV. The Rejection Under 35 U.S.C. § 112, Second Paragraph

The cancellation of claim 1 renders this rejection moot.

V. The Rejection Under 35 U.S.C. § 102(e)

The anticipation rejection of claims 1, 13 and 21 have been rendered moot by the cancellation of those claim, but claims 2-7, 10, and 12, and 14-20 remain rejected as anticipated by *Reichman*, U.S. Patent No. 6,738,813 (hereinafter *Reichman*). To be considered anticipated by a reference, however, M.P.E.P. § 2131 requires that a reference teach each and every limitation of the claims rejected. The Applicant respectfully asserts that *Reichman* does not teach each and every limitation of claims 2-7, 10, and 12-21.

Claims 2-7 and 10 depend from claim 22, and thus inherit all of that claim's limitations. Claim 22 recites "a networked device, connected to a digital network, performing a dedicated stand-alone function." The Applicant respectfully submits that *Reichman* does not contain such a networked device. The current action cites computing devices 34 of *Reichman* as being "network device[s]" as intended in the rejected claims, but the Applicant respectfully points out that computing devices 34 are consumer PC's, not devices performing a dedicated standalone function. Thus, *Reichman* does not teach at least this limitation of claims 1-7 and 10, and the Applicant respectfully asks the Examiner to withdraw the § 102(e) rejection of these claims.

Claim 12 recites "collecting information from a networked device pertaining to an ability of said networked device to perform a function . . . [and] automatically analyzing [a] message to determine an appropriate modification of said networked device." The Applicant respectfully submits that *Reichman* does not teach this limitation. In rejecting claim 12, the Current Action has equated consumer PC's 34 to a networked device. However, the Applicant respectfully submits that the information collected by the PC's in *Reichman* does not "[pertain] to an ability of said networked device to perform a function." Instead, the information collected by *Reichman*'s PC's relate to the ability of transaction server 30 to communicate over a network. Thus a consumer PC's from *Reichman* does not correspond to a networked device of claim 12. In addition, the actions taken by the system of *Reichman* are to the network connections, not to an element of *Reichman* the Examiner can equate with a

networked device. Therefore, *Reichman* does not teach each and every limitation of claim 12, and the applicant respectfully asks the Examiner to withdraw the § 102 rejection of this claim.

Claims 14-20 depend from claim 12 and thus inherit all of that claim's limitations. Although claims 14-20 recite limitations that make each of these claims patentable in their own right, they are at least patentable for depending from a patentable base claim. Thus, the Applicant respectfully asks the Examiner to withdraw the rejections of Claims 14-20 as well.

VI. The Rejections Under 35 U.S.C. § 103(a)

The Current Action rejects claims 8 and 9 as obvious over the combination of *Reichman* and Oskay et al., U.S. 5,642,337 (hereinafter *Oskay*). M.P.E.P. § 2143 states that, in order to establish a prima facie case of obviousness, a cited combination must, among other things, teach or suggest each and every limitation of a rejected claim without conceding that Current Action has established the other criteria for establishing a prima facie case of obviousness, the Applicant respectfully submits that the Current Action's proposed combination does not teach or suggest all of the limitations of claims 8 and 9. Claims 8 and 9 depend from claim 22 and inherit all of that claim's limitations. As demonstrated above, *Reichman* does not teach or suggest all the limitations of Claim 22. The Applicant respectfully submits that *Oskay* does not teach the missing limitations either. Therefore, the combination of *Reichman* and *Oskay* does not teach or suggest all of the limitations of claims 8 and 9, and the applicant respectfully asks the Examiner to withdraw the rejection.

The Current Action Rejects claim 11 as obvious over the combination of *Reichman* and Moberg et al., U.S. Patent No. 6,738,826 (hereinafter *Moberg*). M.P.E.P. § 2143 states that, in order to establish a prima facie case of obviousness, a cited combination must, among other things, teach or suggest each and every limitation of a rejected claim without conceding that Current Action has established the other criteria for establishing a prima facie case of obviousness, the Applicant respectfully submits that the Current Action's proposed combination does not teach or suggest all of the limitations of claim 11. Claim 11 depends from claim 22 and inherits all of that claim's limitations. As demonstrated above, *Reichman* does not teach or suggest all the limitations of claim 22. The Applicant respectfully submits that *Oskay* does not teach or suggest the missing limitations either. Therefore, the

combination of *Reichman* and *Oskay* does not teach or suggest all of the limitations of claim 11, and the applicant respectfully asks the Examiner to withdraw the rejection.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Applicant believes no additional fee is due with this response other than the additional claim fees addressed in the accompanying transmittal. However, if an additional fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10005002-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as Express Mail, Airbill No. EV629197570US in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date of Deposit: April 26, 2005

Typed Name: Laura Horton

Signature: 

Respectfully submitted,

By 

Michael A. Papalas

Reg. No.: 40,381

Date: April 26, 2005

Telephone No. (214) 855-8186